APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,726	02/14/2001	Mihal Lazaridis	1400-1072 D2	7167

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EXAMINER
REILLY, SEAN M

ART UNIT	PAPER NUMBER
2153	

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/783,726	LAZARIDIS ET AL.
	Examiner	Art Unit
	Sean Reilly	2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 August 2006*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *102-129* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *102-129* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *8/11/06*.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to Applicant's amendment and request for

reconsideration filed on June 28, 2006. All previously pending claims have been canceled. New

claims 102-129 are presented for further examination.

Response to Arguments

1.   In response to Applicant's request for reconsideration filed on June 28, 2006, the following

factual arguments are noted:

   a.   The combination of AirMobile and Carthy is invalid.

In considering (a), Examiner respectfully disagrees with Applicant's argument.

Applicant asserts that the incorporation of Carthy's full asynchronous notification within the

AirMobile system requires a major redesign of the AirMobile system and changes the basic

operation principle under which AirMobile operates. Applicant's arguments are not persuasive

on any level. Applicant has merely provided baseless assertions that simply confuse and distort

the issues at hand. It is certainly within the skill set of one of ordinary skill in the art to replace a

software polling interface with a full asynchronous notification interface. Furthermore this is the

entire point of Carthy's disclosure. A through review of Carthy revels that the user "stephane

COHEN" currently utilizes a polling scheme similar to the one used in AirMobile and is looking

for a way to be automatically notified upon the receipt of new mail in a mailbox. In response,

the user "Claran Carthy" discloses that the use of a simple MAPI API interface can be utilized to

register for such notifications. Contrary to what Applicant appears to assert, it is clearly not a

leap of logic to move from a polling scheme to a full asynchronous notification scheme in view

of Carthy. Additionally Applicant has not provided any evidence to demonstrate how such

changes would require a substantial redesign of the AirMobile system or changes to the basic

operating principle which AirMobile operates. The entire point of Air Mobile's system is to

push messages to mobile clients as they are received at the cc:Mail server. There are no major

architecture changes or changes to the basic operating principle of the system required; rather a

different software API interface is merely utilized. Examiner maintains that the outstanding

combination of AirMobile and Carthy is clearly valid and is thus MAINTAINED. Furthermore

Examiner notes that Applicant did not conceive MAPI and moreover clearly was not the first to

conceive the use of use MAPI APIs for the full asynchronous notification of new mail that

arrives within an email server mailbox and in response to such a notification, forwarding the new

email to the intended recipient.

Information Disclosure Statement

2.   The information disclosure statement (IDS) submitted on August 11, 2006 is not in

compliance. Two references on the last page of the IDS do not contain a publication date.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine

grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA

1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to

overcome an actual or provisional rejection based on a nonstatutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this

application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal

disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37

CFR 3.73(b).

1. **Claims 102-129 are provisionally rejected under the judicially created doctrine of

obviousness-type double patenting as being unpatentable over claims 126-212 of copending

Application No. 10/207,418.** Although the conflicting claims are not identical, they are not

patentably distinct from each other. Refer to the tables for specific claim mappings of equivalent

claim language in the exemplarily claims below.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting

claims have not in fact been patented.

Co-pending Application # 10/207,418	Instant Application # 09/783,726
126. A method of replicating data items from a computer system to a mobile data	102. A method of pushing user data items from a messaging host system to a wireless

communication device of a user, the method comprising the steps of :	mobile data device that is associated with a computer connected over a network to the messaging host system, the method comprising the steps of:
Receiving a data item at the computer system and automatically generating a notification pertaining to the data item upon receipt of the data item, the data item having an address associated with a mailbox of the user; and	Receiving an automatically generated notification at a redirector component indicating receipt of a user data item by the messaging host system,
Pushing the data item from the computer system to the mobile data communication device of the user, the pushing including receiving the automatically generated notification pertaining to the data item by a redirector component and sending an instance of the data item by the redirector component to the mobile data communication device of the user.	Sending the copy of the user data item form the redirector component to the wireless mobile data device.

2.   **Claims 102-129 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 90-109 of copending Application No. 09/782107.** Although the conflicting claims are not identical, they are not

patentably distinct from each other. This is a <u>provisional</u> obviousness-type double patenting

rejection because the conflicting claims have not in fact been patented.

The sole difference between the instant claims and the '107 claims is the use of

encryption between the redirector component and the mobile data device. As evidenced by at

least Murota, it was widely known in the art at the time of Applicant's invention to use

encryption to send messages securely between two parties. In a similar email system, Murota

disclosed encrypting e-mail messages between a sender and a receiver, wherein a message is

encrypted at the sending end, is then transmitted over the network to the receiving end, and is

finally decrypted at the receiving computer (col. 1, lines 23-48). Murota further disclosed that

such an encryption scheme is advantageous because it prevents leaks of secret information to

outside, non-intended parties (Murota, col. 1, lines 49-53). Thus, given the teaching of Murota,

it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention

to include an encryption function, as taught by Murota, in conjunction with the redirector

component of Applicant's claimed invention such that messages sent between the Applicant's

redirector component and the mobile device are encrypted, in order to prevent outside parties

from having access to secret or classified messages.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

3.   **Claims 102-104, 106-113, 115-122, 124-129 are rejected under 35 U.S.C. 103(a) as**

being unpatentable over AirMobile (Software for Lotus cc:Mail Wireless, Communication

Client Guide, Motorola, 1995) and Carthy et al. (MAPI Developers Forum post "MAPI

Notification" April 12, 1996; hereinafter Carthy) and Eggleston et al. (U.S. Patent No.

5,764,899, hereinafter "Eggleston").

4.   With regard to claim 102, AirMobile disclosed a method of pushing user data items from

a messaging host system ("communication server") to a wireless mobile data device that is

associated with a computer (i.e. the mobile device in AirMobile is in and of itself a computer)

connected over a network to the messaging host system (p. 9, "Communication Server," p. 10,

"User Profile Database," pp. 15-16, wherein mail is received and stored at the communication

server, and the mail account is associated with a mobile device according the device ID), the

method comprising the steps of:

- ❏ Receiving a notification at a redirector component indicating receipt of a user data

     item by the messaging host system, where the notification is generated in response to

     receipt of the user data item at the messaging host system and wherein the user data

     item is addressed to a data store that is associated with the messaging host system and

     is viewable via the computer (e.g. Airmobile pushes received messages to the mobile

     clients and this push algorithm is invoked by some internal notification; see inter alia

     pgs 30 and 31 "enables messages to be immediately downloaded when they are

     received"];

❑ Processing the user data item at the redirector component to add address information associated with the wireless mobile data device (required for delivery to the mobile client, see pg 31 ¶s 1-3);

❑ Sending the user data item form the redirector component to the wireless mobile data device over a wireless network (the actual push or download of the message to the mobile device pg 31, ¶s 1-3).

AirMobile disclosed the invention substantially as claimed, however Airmobile failed to specifically recite 1) that the *notification* is *automatically generated* in response to receipt of the user data item and 2) transmitting a *copy* of the received electronic message.

With regard to point (1), AirMobile failed to specifically recite that the *notification* is *automatically generated* in response to receipt of the user data item. AirMobile disclosed a server side push technology (pg 31 ¶ 1-3), where the server must internally poll for the arrival on new messages in a user's mailbox. Nonetheless Examiner maintains that such an automatic notification must occur in the system in order for the actual forwarding software to be invoked within the computer system. Furthermore even if one were to argue persuasively that such a notification is not inherent then Examiner maintains that adding a new data item automatic notification feature would have been an obvious modification to AirMobile at the time of Applicant's invention, in view of at least Carthy. In a similar art, Carthy disclosed an e-mail system where the notification of new messages in a user's mailbox is sent **automatically,** as opposed to polling, using an extended MAPI IMAPIadviseSink notification (See the Carthy post

describing "full asynchronous" notification in extended MAPI). Carthy further disclosed that in

order to receive these automatic notifications the system must register with a software interface

associated with the messaging server (i.e. registering with the ImsgStore to receive adviseSinks).

Cathy also disclosed that automatic notification is preferable to polling (see the Cohen post

below: "Today I do a polling on each mailbox : I open a connection through MAPI functions, I

consult, I notify if new mail, and I close the connection. Then I go to the next mailbox and do

the same actions. It's not great ☹. So I'd like to know whether –there- exists another way to

notify with MAPI, especially a "fully asynchronous" notification"). Automatic notification is

preferable to polling for detecting the arrival of new messages since the detection process is

more efficient. For example the system no longer has the delay associated with polling each

user's mailbox and is instead alerted immediately of the arrival of new messages. Additionally

less system resources are consumed since the system no longer has to poll the mailbox of each

user in order to detect new messages. Thus, it would have been obvious to one of ordinary skill

in the art at the time of the invention to incorporate the automatic notification functionally

disclosed by Carthy within AirMobile's system, since Carthy disclosed automatic notification is

preferable to polling and further since the use of automatic notification is more efficient. Again

automatic notification is more efficient since the system is alerted immediately of the arrival of

new messages and less system resources are consumed.

With regard to point (2), AirMobile discloses forwarding messages received at the

messaging server to the wireless device. However, AirMobile does not *explicitly* state that the

messages forwarded to the wireless mail system are a *copy*. Nonetheless, most e-mail systems

that forward messages actually replicate the messages before forwarding, so that a copy of the

message is retained in the initial destination mailbox. Such replication is disclosed by Eggleston.

In a similar art, Eggleston teaches a system for forwarding messages from a LAN-based host

through a wireless host to a mobile client device, wherein the LAN-based host stores messages,

thereby maintaining a replica of the messages, before forwarding them to the client (col. 4, lines

44-51; col. 12, lines 32-39, 59-62, wherein the messages are copied and maintained at a host

system, and are also sent to target units). Thus, given the teaching of Eggleston, a person having

ordinary skill in the art would have readily recognized the desirability and advantages of

replicating the messages at the messaging server taught by AirMobile, to preserve received

messages in case the client memory fails or the message is lost in transmission. Therefore, it

would have been obvious to include the mail replication feature taught by Eggleston in the mail

forwarding system taught by AirMobile and Carthy.

With regard to claim 103, AirMobile disclosed the redirector component is operating on

the messaging host system (pg 9 "communication server" and pg 31 ¶s 1-3).

With regard to claim 104, AirMobile disclosed the redirector component is operating on a

host system that is couple to the message host system via the network (e.g. the Network fiel

server cc:Mail Postoffice works in tandem with the Windows AirMobile server pg 9).

With regard to claim 106, Eggleston disclosed that messages sent between the wired and

wireless systems can be compressed (col. 11, lines 63-67). Given this knowledge, it would have

been obvious to a person having ordinary skill in the art to compress the messages in the system

taught by AirMobile, Carthy, Bezaire, and Eggleston, prior to transmission to the gateway, and

to decompress the messages at the mobile device, as suggested by Eggleston, in order to increase

available bandwidth and to provide faster and less expensive communications (see Eggleston,

col. 12, lines 7-9).

With regard to claim 107, AirMobile disclosed the processing step further comprises

encoding the copy of the user data item (e.g. transforming a message into the required

transmission protocol for the wireless network being utilizing prior to pushing a message to the

user) (additionally compressing as set forth with regard to claim 106 is a form of encoding).

With regard to claim 108, Examiner takes official notice that the Multipurpose Internet

Mail Extensions protocol was widely known and used to communicate email messages between

devices at the time of Applicant's invention. Thus, it would have been obvious to one of

ordinary skill in the art at the time of Applicant's invention to encode messages using the MIME

protocol within AirMobile's system in order to communicate messages between devices using a

known reliable protocol.

With regard to claim 109, AirMobile disclosed the user data item is an email (pg. 38,

"Sending/Transmitting e-mail messages").

With regard to claim 110, AirMobile disclosed the data store address is an email mailbox

at the messaging host system associated with a user of the computer and the wireless mobile data

device ("cc:Mail" address, p. 38, "Sending/Transmitting e-mail messages").

With regard to claim 111, AirMobile disclosed the step of sending the copy of the user

data item from the redirector component to the wireless mobile data device over the wireless

network further comprises sending the copy of the user data item via a wireless gateway

disposed between a wide area network and the wireless network (see pg 9, Figure 1-1, a gateway

is required to interface between the networks).

With regard to claim 112, AirMobile disclosed the step of storing the user data item at the

data store associated with the messaging host system (p. 9, "Communication Server," p. 10,

"User Profile Database," pp. 15-16, wherein mail is received and stored at the communication

server, and the mail account is associated with a mobile device according the device ID).

Claims 113, 115-122, and 124-129 are rejected using a similar rationale as applied to

claims 102-104 and 106-112.

3. Claims 105, 114, 123 are rejected under 35 U.S.C. 103(a) as being unpatentable over

AirMobile Server (AirMobile Wireless Software for Lotus cc:Mail, Communication Server

Guide, Motorola, 1995), in view of AirMobile Client (AirMobile Wireless Software for

Lotus cc:Mail, Communication Client Guide, Motorola, 1995), and Carthy et al. (MAPI

Developers Forum post "MAPI Notification" April 12, 1996; hereinafter Carthy) and

Eggleston et al. (U.S. Patent No. 5,764,899, hereinafter "Eggleston") and further in view of Murota (U.S. Patent No. 6,289,105).

Note, the AirMobile Server and AirMobile Client guide present different aspects of the same system, and are therefore are treated as a single system for the purposes of this rejection. They are hereinafter referred to together as "AirMobile" with specific citations to the Server guide as "AirMobileS" and the Client guide as "AirMobileC."

AirMobileS disclosed sending messages from the cc:Mail server to the mobile device in a secure fashion (AirMobileS, p. 25, bullet 1 "secure and authenticated virtual wireless communication channel between your laptop and your LAN-based cc:Mail server") however, AirMobile does not disclose using encryption for sending messages in a secure fashion. Nonetheless the use of encryption to send messages securely was widely known in the art at the time of Applicant's invention, as evidenced by at least Murota. In a similar email system, Murota disclosed encrypting e-mail messages between a sender and a receiver, wherein a message is encrypted at the sending end, is then transmitted over the network to the receiving end, and is finally decrypted at the receiving computer (col. 1, lines 23-48). Murota further disclosed that such an encryption scheme is advantageous because it prevents leaks of secret information to outside, non-intended parties (Murota, col. 1, lines 49-53). Thus, given the teaching of Murota, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention include an encryption function, as taught by Murota, in conjunction with the redirector component of AirMobile such that messages sent between the AirMobile server and mobile devices are encrypted, in order to prevent outside parties from having access to secret or classified messages.

Conclusion

4. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent

to applicant's disclosure.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The

examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 28, 2006

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